

### Remarks

The Applicants note with appreciation the withdrawal of the 35 USC §103 rejection over the combination of ASM Handbook with Kushida and the obviousness-type double-patenting rejection.

Claim 1 stands objected to as not being clear due to a typographical error. The Applicants have amended Claim 24 to correct the typographical error and insert the “greater than or equal to” symbols. Withdrawal of the objection is respectfully requested.

Claim 24 (actually noted as Claim 1 in the rejection) stands rejected under 35 USC §112 as being indefinite with respect to the “the texture further contains...” language. The Applicants have amended Claim 24 to delete “the texture further” and have added “and” in its place. Thus, Claim 24 now reads “and contains...” Withdrawal of the §112 rejection is respectfully requested.

Claim 1 has further been amended to recite that the stainless steel seamless pipe has a ferrite phase and a volume fraction between 10% and 60%. Support may be found throughout the Applicants’ Specification such as in paragraph [0053] on page 21. Also, support may be found in Claim 33. Claim 33 has been amended accordingly.

Claims 24-34 stand rejected under 35 USC §103 over JP ‘009. The Applicants note with appreciation the Examiner’s helpful comments hypothetically applying JP ‘009 against the claims. However, the Applicants respectfully submit that JP ‘009 is inapplicable for the reasons set forth below.

The Applicants respectfully submit that the rejection is now moot with respect to Claims 24-32 in view of the amendment to Claim 24. Thus, the following points are directed to the comments with respect to Claims 33 and 34. In that regard, the rejection frankly acknowledges

that JP '009 does not disclose the recited ferrite phase volume fractions. Instead, however, the rejection notes that paragraph [0031] of JP '009 discloses that a diffraction intensity from (211) of alpha is present. Thus, the rejection concludes that a ferrite phase is present in the stainless steel seamless pipe of JP '009 and that since the compositions and methodology are similar, the JP '009 stainless steel pipes would have similar volume fractions of the ferrite phase. In other words, the rejection takes the position that the Applicants' claimed ferrite phase would "inherently" be present in the JP '009 stainless steels.

In utilizing inherency to reject claims under §103, MPEP §2112 requires that the characteristic at issue, namely the amount of ferrite in this case, is "necessarily" present. It is not enough that the prior art, namely JP '009 in this case, provides disclosure that the characteristic at issue might be, could be or is even likely present. The prior art must establish that the characteristic at issue is "necessarily" present.

The Applicants respectfully submit that JP '009 does not provide disclosure that meets this very high requirement. In particular, the Applicants confirm that paragraph [0031] mentions a "diffraction intensity from (211) alpha." That disclosure is made in the context of the testing and measurement that was done on all of the test pieces. This particular disclosure is directed to the diffraction intensities obtained from an X-ray diffractometer. It should be noted, however, that this is a discussion of all of the test pieces. All of the test pieces include the examples and comparative examples.

Then, moving to the Table on page 10 of JP '009, it can be seen that three different phases are at least mentioned. The "TM" refers to martensite, while "gamma ( $\gamma$ )" refers to austenite and "alpha ( $\alpha$ )" refers to ferrite. These definitions are provided just below the Table. Then, referring to the Table itself, all of the examples and comparative examples have references

to martensite (TM). This is for all of numbers 1-20. The references to ferrite ( $\alpha$ ) are limited to Steels 11, 14 and 16. However, it should be noted in the far right-hand column, that those steels are comparative examples, not examples of the JP '009 steels.

In sharp contrast, none of the examples refer to a percentage of ferrite ( $\alpha$ ). Therefore, there is no disclosure of the presence of ferrite ( $\alpha$ ) in any of the JP '009 inventive steels. The Table also provides for specific amounts of austenite ( $\gamma$ ) which implies that the balance of the phase is left to either martensite (TM) and ferrite ( $\alpha$ ) in Steels 11, 14 and 16, which are comparative examples, and that the balance of the phase in the JP '009 inventive steels is martensite. In other words, would it not have been logical to include references to the presence of ferrite ( $\alpha$ ), in the inventive examples if ferrite ( $\alpha$ ) was actually present in those samples?

The Applicants believe that the answer to that question is yes. Thus, the implication is that there apparently is no ferrite ( $\alpha$ ) present in the inventive steels. However, one skilled in the art can only speculate as to the presence of ferrite ( $\alpha$ ) in the inventive examples. Further, one skilled in the art can only speculate as to what the amount of such speculative ferrite ( $\alpha$ ) would actually be present if that ferrite was present.

The Applicants respectfully submit that this serious uncertainty means that one skilled in the art cannot have a reasonable belief that ferrite is "necessarily" present in the claimed volume fraction. There is simply too much uncertainty in the JP '009 disclosure to meet that very high burden. Given the inability to establish that the claimed volume percent of ferrite is "necessarily" present, the Applicants respectfully submit that inherency cannot be established and that the rejection under §103 cannot be maintained. Withdrawal of the rejection is respectfully requested.

In light of the foregoing, the Applicants respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'TDC', is written above the printed name.

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